

### REMARKS

This Application has been carefully reviewed in light of the Office Action mailed May 3, 2004. Applicant appreciates the Examiner's consideration of the Application. Claims 1, 11, and 19 have been amended to clarify, more particularly point out, and more distinctly claim inventive concepts previously present in these claims. Applicant respectfully submits that no new matter has been added by the amendments to the claims. In order to advance prosecution of this Application, Applicant has responded to each notation by the Examiner. Applicant respectfully requests reconsideration and favorable action in this case.

#### Section 112 Rejections

The Examiner rejects claims 1-20 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended Claims 1, 11, and 19 to make more clear the reference to "logic events". With regard to the Examiner's understanding of the terms "a set of logic events associated with said circuit", the Examiner is directed to the Specification at page 4, lines 23-30, FIGURE 3, and page 9, lines 12-32 through page 10, lines 1-17.

#### Section 103 Rejections

The Examiner rejects claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,729,554 issued to Weir et al. ("*Weir*") in view of U.S. Patent No. 6,618,856 B2 issued to Coburn et al. ("*Coburn*"). Applicant respectfully traverses this rejection for the reasons discussed below.

First, *Weir*, either alone or in combination with *Coburn*, fails to disclose, teach, or suggest "tabulating for the plurality of input test cases and the set of logic events the numbers of times that each input test case stimulates each logic event", as recited by Applicant's independent claims 1, 11, and 19, as amended. The Examiner points to Column 7, Lines 16-29 in *Weir* where as disclosing where "occurrences and non-occurrences of events are considered". (Office Action, page 4, paragraph 1). In that passage *Weir* states:

The utility of the present invention may also be helpful in controlling the rate at which certain events occur. For example, if a test pattern is a branch instruction, information about the branch can be analyzed,

including whether the branch was taken and whether it branched forward or backward. The branch test pattern may be accepted or rejected to provide a test case containing an equal number of taken and not-taken branches or so that an equal number of forward and backward branches occur.

That passage of *Weir*, however, refers to analyzing information related to the branches, whether taken or not-taken. Even if, for argument's sake, the information related to whether a branch was taken or not taken were construed as teaching occurring and non-occurring events, *Weir*'s analysis does not disclose "tabulating for the plurality of input test cases and the set of logic events", as recited in Applicant's claims 1, 11, and 19 as amended.

In fact, *Weir* mentions "tracking of events" as follows:

Tracking of events allows the user to analyze and improve the type of coverage the tests produce. By including a history of events created by past test patterns, test patterns can be "accepted" if they produce a new event or "rejected" if they cause events that have already been tested. In the preferred embodiment, events are stored to a file by piping events to a file using a UNIX socket.

*Weir*, Column 8, Lines 21-27. That is, *Weir*, at most, stores single occurrences of occurring events while rejecting test patterns that cause events already tested, but does not tabulate "for the plurality of input test cases and the set of logic events the numbers of times that each input test case stimulates each logic event". *Coburn* also fails to disclose, teach, or suggest "tabulating for the plurality of input test cases and the set of logic events the numbers of times that each input test case stimulates each logic event". Therefore, *Weir*, whether alone or in combination with *Coburn*, fails to disclose, teach, or suggest the combination of limitations specifically recited in Applicant's claims 1, 11, and 19.

Furthermore, it would not be obvious to modify *Weir* to tabulate "the number of times" because *Weir* has no use for tabulating the number of times a test case stimulates each logic event, i.e. both occurring and non-occurring events. From the above mentioned passage, it is clear that *Weir* uses the information of what events have already been caused to determine whether to accept or reject a test pattern, *Weir* therefore has no need to also track *how many times* an event occurs or does not occur. Consequently, *Weir* does not provide any motivation to combine, with *Coburn* or other references, or motivation to modify *Weir* to include "tabulating for the plurality of input test cases and the set of logic events the numbers

of times that each input test case stimulates each logic event", as recited by Applicant's independent claims 1, 11, and 19, as amended.

Applicant respectfully requests that the Examiner withdraw the rejection to claims 1, 11, and 19. Claims 2-10, 12-18 and 20 are therefore also allowable because they depend on the independent claims 1, 11, and 19 and further because they contain numerous patentable distinctions over the cited references. Applicant respectfully requests reconsideration and allowance of independent claims 1, 11, and 19 and all claims that depend on these claims.

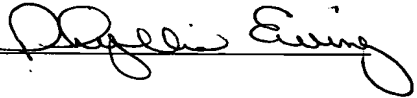
In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10002450-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV 482734987 US in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313.

Date of Deposit: July 22, 2004

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Respectfully submitted,

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